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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/709,247	04/23/2004	James M. Murphy	PU2211	3246
23454	7590	10/18/2005	EXAMINER	
CALLAWAY GOLF COMPANY 2180 RUTHERFORD ROAD CARLSBAD, CA 92008-7328			HUNTER, ALVIN A	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

ℓ

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/709,247	MURPHY ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Alvin A. Hunter	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☒ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4/23/04</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Specification*

The abstract of the disclosure is objected to because the abstract is longer than 150 words. Correction is required. See MPEP § 608.01(b).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1-3, 5, 6, 8, 10, 11, 13, 14, 18, 21-26, 31, 33-37, and 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nagai et al. (USPN 5967904).

Regarding claim 1, 3-5, 7, and 8, Nagai et al. discloses a face component, and an aft body in the form of a crown and sole component connected to the face component wherein the head has a mass and volume of 170-220 grams and 220-320 cc respectively. Nagai et al. also discloses the face component composed of metal and inherently having a mass and the aft body having a mass. Nagai et al. does not disclose the mass of the face and aft body components separately but clearly the face component in Figure 2 appears to be the largest component. At the minimum, if the face component was the same amount of material as the sole or crown component for constructing a 180 grams club head, each component would have a mass of 60 grams. Nagai et al. does not explicitly disclose the mass of the face component and the aft body, and the weight member, but one having ordinary skill in the art would have found

it obvious to modify the club head for each component to have the mass as that claimed in the instant application in order to have sufficient rigidity for each of the face, crown, and sole components.

Claims 4, 12, 19, 20, 27, 38, 39, 41-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagai et al. (USPN ) in view of Beach et al. (USPN 6623378)..

Regarding claims 4, 12, 19, 20, 27, 38, 39, 41-45, Nagai et al. does not disclose having the aft body made of a plurality of pre-preg material. Beach et al. discloses a club head having a face component made of metal and an aft body made of a plurality of pre-preg material (See Summary of the invention and Column 3, lines 34 through 54). One having ordinary skill in the art would have found it obvious to have the aft body made of a plurality of pre-preg plies, as taught by Beach et al., in order to allow for increased volume while retaining strength. The coefficient of restitution would be an inherent result of the combination of the materials being used to construct the club head, wherein above combination teaches a club head having a face component made of metal, an aft body made of a composite material, and a weight member.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-45 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6491592. Although the conflicting claims are not identical, they are not patentably distinct from each other because US patent No. 6491592 does not claim the mass of the components. Though the mass are not claimed, one having ordinary skill in the art would find the weight of each component to be suitably selected such that the club head has a mass of 175 to 225 grams and, therefore, would have been obvious.

Claims 1-7, 9-17, 19, 20, 25-30, 32, 38, 40, and 45 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6648773. Although the conflicting claims are not identical, they are not patentably distinct from each other because US Patent 6648773 claims the same subject matter except that weight of the face component and the body component are not exactly the same. Though the weights are not exactly the same the weights are anticipated at particular points. One having ordinary skill in the art would have found it obvious to have the weight of the face component and the body of any value so long as the invention is attained.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin A. Hunter whose telephone number is (571) 272-

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4411. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich, can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AAN

Alvin A. Hunter, Jr.



**EUGENE KIM**  
**PRIMARY EXAMINER**